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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,261	04/12/2001	Hans-Michael Kuhl	22750/405A	5004
26646	7590	07/13/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	
DATE MAILED: 07/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/835,261	Applicant(s) KUHL ET AL.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03-29-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03-29-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The RCE is acknowledged.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/10160 to Kjellqvist et al. in view of USPN 5,571,588 to Lussi et al.

Kjellqvist provides for floor coverings using copolymers containing α -olefins having 2-20 carbons at page 5, lines 5-14 containing monomer ethylene or a combination of ethylene with α -olefins. Testing properties such as ultimate tensile strength and elongation are measured according to DIN 53504, specimen S2, 50 mm/min. cross head speed (see page 32-33). The elongation percentages are taught in Tables 3 and 4 ranging from 31.9 to 776 % (meeting applicant's range of a minimum elongation of 60%). The melt flow index of ethylene/styrene copolymer ranges from 1-30 g/10 min in Table 1C (col. 19, lines 40-55) (meeting applicant's range of 0.1 to 50). The floor covering of Kjellqvist generally has a thickness of from about 0.025 mm to about 25 mm (see page 25, lines 34-page 26, line 15), meeting Applicant's claimed range of 1.5 – 3.5 mm. Pages 44 and 47 explain floor coverings are useful as homogeneous coverings or as an individual layer in a heterogeneous structure. At page 31, line

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3, pigments may also be included. At page 28, lines 15-22, Kjellqvist teaches the floor coverings can contain adhesive and decorative layers.

Kjellqvist does not teach a multicolored pattern provided by granular particles as instant claims 1, 3, and 5-6 require.

Lussi teaches floor coverings with unpatterned decorative appearances. Lussi teaches at col. 5, line 65-col. 6, line 2 multicolored spheroidal resinous particles (granular particles) are used to give a uniform, unpatterned, textured inlaid appearance to the floor coverings. The particles comprise PVC (see col. 5, line 63). The floor covering includes crosslinkable copolymers in the latex layer, which include crosslinkable ethylene vinyl acetate latexes, crosslinkable acrylic latexes, ethylene vinyl chloride emulsions, PVC and polyvinyl acetate latexes, PVC and polyvinyl acetate copolymer latexes, and butadiene-acrylnitrile latexes. The latex layer includes color, providing for a multicolored or single color (instant claims 1, 3, and 5-6). See col. 4, lines 20-30.

It would have been obvious to one of ordinary skill in the art to modify the floor covering of Kjellqvist to include granular colored (multi-and single colored) particles in a pattern because Lussi teaches doing so with similar materials to create a textured colored floor covering as cited above.

Kjellqvist does not show the specific percentages by weight of the copolymer and comonomer, as in instant claims 1 and 2.

However, such ranges and percentages of weight are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges and percentages of weight, absent a showing of unexpected results, it is obvious to modify the

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conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges and percentages of weight) fails to render claims patentable in the absence of unexpected results.

See col. 12, lines 1-30 to the amounts of interpolymers and α -olefins weight percentages. See also 5 teaching a composition weight percent of 8. It would have been obvious to one of ordinary skill in the art to produce the weight percentages as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The amounts affect the scratch resistance.

To the limitation “wherein the floor covering having widths of 1 m to 2 m and has no change in thickness exceeding +5% over the width,” neither prior art reference teaches, however this limitation is an optimizable feature. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render Applicant’s claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. It would have been obvious to one of ordinary skill in the art to produce a width as recited, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Width effects how thin the covering is. Size of an article does not render the article patentable just because it is a different size. The combination teaches the same article, thus patentable weight is not given to width requirements, absent any evidence to the contrary. Such ranges width and thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges of width and thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a covering because they are merely the result of routine experimentation. The experimental modification of

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prior art in order to optimize operation conditions (e.g. ranges of width and thickness) fails to render claims patentable in the absence of unexpected results.

3. Claims 1-3, and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,254,956 to Kjellqvist et al. in view of USPN 5,571,588 to Lussi et al.

Kjellqvist provides for floor coverings using copolymers containing α -olefins having 2-20 carbons at col. 2, lines 65-68 containing monomer ethylene or a combination of ethylene with α -olefins. See col. 3, lines 1-5. Testing properties such as ultimate tensile strength and elongation are measured according to DIN 53504, specimen S2, 50 mm/min. cross head speed (see col. 16, lines 40-41). The elongation percentages are taught in Tables 3 and 4 ranging from 31.9 to 776 % (meeting applicant's range of a minimum elongation of 60%). The melt flow index of ethylene/styrene copolymer ranges from 1-30 g/10 min in Table 1C (col. 19, lines 40-55) (meeting applicant's range of 0.1 to 50). The floor covering of Kjellqvist generally has a thickness of from about 0.025 mm to about 25 mm (see col. 13, lines 4-9), meeting Applicant's claimed range of 1.5 – 3.5 mm. Col. 21, lines 60-68 and col. 22, lines 60-68 explain floor coverings are useful as homogeneous coverings or as an individual layer in a heterogeneous structure. At col. 15, line 24, pigments may also be included. At col. 14, lines 14-18, Kjellqvist teaches the floor coverings can contain adhesive and decorative layers.

Kjellqvist does not teach a multicolored pattern provided by granular particles as instant claims 1, 3, and 5-6 require.

Lussi teaches floor coverings with unpatterned decorative appearances. Lussi teaches at col. 5, line 65-col. 6, line 2 multicolored spheroidal resinous particles (granular particles) are

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used to give a uniform, unpatterned, textured inlaid appearance to the floor coverings. The particles comprise PVC (see col. 5, line 63). The floor covering includes crosslinkable copolymers in the latex layer, which include crosslinkable ethylene vinyl acetate latexes, crosslinkable acrylic latexes, ethylene vinyl chloride emulsions, PVC and polyvinyl acetate latexes, PVC and polyvinyl acetate copolymer latexes, and butadiene-acrylnitrile latexes. The latex layer includes color, providing for a multicolored or single color (instant claims 1, 3, and 5-6). See col. 4, lines 20-30.

It would have been obvious to one of ordinary skill in the art to modify the floor covering of Kjellqvist to include granular colored (multi-and single colored) particles in a pattern because Lussi teaches doing so with similar materials to create a textured colored floor covering as cited above.

Kjellqvist does not show the specific percentages by weight of the copolymer and comonomer, as in instant claims 1 and 2.

However, such ranges and percentages of weight are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges and percentages of weight, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges and percentages of weight) fails to render claims patentable in the absence of unexpected results. See col. 12, lines 1-30 to the amounts of interpolymer and α -olefins weight percentages. See also 5 teaching a composition weight percent of 8. It would have been obvious to one of ordinary skill in the art to produce the weight percentages as claimed, since it has been held that

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discovering an optimum value of a result effective variable involves only routine skill in the art.

In re Boesch, 617 F.2d 272. The amounts affect the scratch resistance.

To the limitation “wherein the floor covering having widths of 1 m to 2 m and has no change in thickness exceeding +5% over the width,” neither prior art reference teaches, however this limitation is an optimizable feature. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render Applicant’s claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. It would have been obvious to one of ordinary skill in the art to produce a width as recited, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Width effects how thin the covering is. Size of an article does not render the article patentable just because it is a different size. The combination teaches the same article, thus patentable weight is not given to width requirements, absent any evidence to the contrary. Such ranges width and thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges of width and thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a covering because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges of width and thickness) fails to render claims patentable in the absence of unexpected results.

Response to Arguments

Applicant's arguments filed 03-29-05 have been fully considered but they are not persuasive.

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Applicant argues the submitted certified translation of the German priority document predates Kjellqvist, however, the translation could not be found. Therefore, the Kjellqvist in view of Lussi stands.

Applicant argues the submitted Declaration under 1.31 proves an invention date of the present invention prior to March 12, 1998. However, the WO reference of Kjellqvist is now applied having a 102(b) date. Applicant's effective filing date is 06/28/1999 and cannot be used to antedate a 102(b) date as the publication date of 4/12/98 is at least one year prior to Applicant's effective filing date of 6/28/99. See MPEP 715.

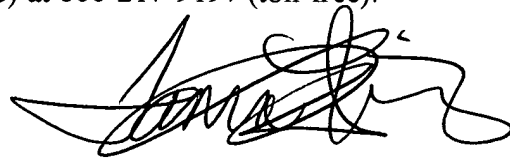
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

June 28, 2005



RENA DYE
SUPERVISORY PATENT EXAMINER

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